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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/332,863	06/15/1999	TERESITA VERGARA IMPERIAL	REV-99-10	3442

7590 12/16/2004

WARD AND OLIVA
708 THIRD AVENUE
NEW YORK, NY 10017

EXAMINER	
MRUK, BRIAN P	
ART UNIT	PAPER NUMBER
1751	

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/332,863	IMPERIAL, TERESITA VERGARA	
	Examiner	Art Unit	
	Brian P Mruk	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *25-98* is/are pending in the application.

4a) Of the above claim(s) *69-97* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *25-68 and 98* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office action is in response to Applicant's amendment filed September 27, 2004. Claims 69-97 remain nonelected. Currently, claims 25-98 remain pending in the application.

2. The text of those sections of Title 35 U.S. Code not included in this action can be found in the prior Office actions, Paper Nos. 13, 16, 21 and 25.

3. The rejection of claims 25, 59 and 60 under 35 U.S.C. 102(b) as being anticipated by Henkel, DE 2,624,690, is maintained for the reasons of record.

4. The rejection of claims 25-47, 50-68 and 98 under 35 U.S.C. 102(a) as being anticipated by Goldwell, DE 19721785, is maintained for the reasons of record.

5. The rejection of claims 26-42 under 35 U.S.C. 103(a) as being unpatentable over Henkel, DE 2,624,690, is maintained for the reasons of record.

6. The rejection of claims 48-49 under 35 U.S.C. 103(a) as being unpatentable over Goldwell, DE 19721785, in view of Yoshihara, U.S. Patent No. 5,332,581, is maintained for the reasons of record.

Response to Arguments

7. Applicant's arguments filed September 27, 2004 have been fully considered but they are not persuasive.

Initially, the examiner would like to note that the prior art rejections withdrawn in the Office action dated June 10, 2003 and reinstated in the Office action dated April 20, 2004 are due to the claims presented by applicant. Specifically, the examiner only withdrew the art rejections in the Office action dated June 10, 2003 in response to applicant amending the claims to contain new matter. Furthermore, the examiner notes that upon applicant amending the instant claims to remove the new matter, that the previous art rejections were reinstated.

Applicant argues that Henkel, DE 2,624,690, does not teach or suggest in general the immediate application required by applicant in claim 25. Namely, applicant argues that Henkel does not teach or suggest in general that the components are mixed together just prior to application to the hair. However, the examiner asserts that this is a product by process limitation, and accordingly, the subject matter would have been obvious to the skilled artisan because the patentability of a product by process claim does not depend on its method of production and where the examiner has found a similar product, the burden rests with the applicant to prove that that product is patentably distinct. See In re Thorpe, 227 USPQ 964 (CAFC 1985); In re Marosi et al, 218 USPQ 289; In re Pilkington, 162 USPQ 145. "The lack of physical description in a product-by-process claim makes the determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is

the patentability of the product claimed and not the process that must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 173 USPQ 685,688 (CCPA 1972). Furthermore, the examiner maintains that applicant's claimed compositions are taught by Henkel when they are mixed together.

Applicant argues that Goldwell, DE 19721785, discloses a composition which contains xanthan gum, whereas the current application discloses that a xanthene-based composition is not suitable for use by those with sensitive or chemically treated hair. However, the examiner asserts that the claims, as presently written, do not exclude xanthan gum, and thus maintains that the instant claims are anticipated by Goldwell.

Applicant further argues that Goldwell does not teach a composition having the component percentages by weight recited in claim 25. The examiner respectfully disagrees. Specifically, the examiner notes that the final composition disclosed in the example of Goldwell contains 8.85% by weight of inorganic persulfate and 1.28% by weight of hydrogen peroxide (i.e. a powder bleach composition) and an aqueous based developer and aqueous based hair colorant, per the requirements of the instant invention. Furthermore, the examiner notes that the amount of water, developer, and hair colorant in the final composition disclosed in the Example of Goldwell meets the 20-

60% by weight requirement of the aqueous based developer/hair colorant compositions required in claim 25, since the 20 grams of water, along with the developers and colorants used in the Example, clearly meet the weight percentages for the developer and colorant compositions required in the instant claims.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Mruk whose telephone number is (571) 272-1321. The examiner can normally be reached on Monday-Thursday from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

BPM
Brian Mruk
December 14, 2004

Brian P. Mruk
Brian P. Mruk
Primary Examiner
Tech Center 1700